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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,833	01/11/2005	Takashi Kawakami	261638US6PCT	7215
22850 7590 02/19/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER SCHWARTZ, DARREN B				
ART UNIT 2435		PAPER NUMBER		
NOTIFICATION DATE 02/19/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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# Office Action Summary

**Application No.**

10/519,833

**Applicant(s)**

KAWAKAMI, TAKASHI

**Examiner**

DARREN SCHWARTZ

**Art Unit**

2435

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2008 and 05 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 03 December 2008 have been fully considered but they are not persuasive.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

1. Applicant argues Utsumi is silent to teaching "a second recording medium different from the first recording medium" and "a recording and reproducing apparatus configured to reproduce various types of recording medium identification information unique to the second recording medium including machine identification data and recording content data transferred from the first recording medium to the second recording medium."

The Examiner disagrees. Applicant admits in REMARKS, filed 03 December 2008, "Utsumi adds 'it is necessary for each of them to have the media ID for identifying the storage medium'...That is Utsumi describes media ID which is unique to each individual storage<sup>5</sup> but, describes similar computer systems utilizing the storage mediums" (page 10 of REMARKS).

Additionally, Utsumi states in the abstract:

"There is provided a license devolution system for devolving the right of using as to contents. The license devolution system makes it possible to copy or

distribute contents while contributing to a protection of the copyright for the contents. Content is encrypted with a first key. The first key and use information are encrypted with a second key consisting of a media ID for identifying a first storage medium in which the first key and the use information are stored. In order to devolve the right of using as to the contents, the content is transferred to a second storage medium of a destination of devolution in the form of encryption. The first key and the use information are decoded with the media ID of the first storage medium, and further encrypted with the media ID of the second storage medium of the destination of devolution into storage in the second storage medium of the destination of devolution."

2. Amended claims 1 and 11 recite a second recording medium different from the first recording medium. Utsumi teaches in Figure 1, distinct elements 10 and 30, the 1st STORAGE MEDIUM and 2nd STORAGE MEDIUM, respectively. Additionally, Utsami teaching a second recording medium including machine identification data in ¶7: "a second storage medium for storing therein a second media ID for identifying one's own self are accessed so that the right of using as to the contents stored in said first storage medium is devolved from said first storage medium to said second storage medium" and in ¶10: "the second media ID to generate a second encryption secure information into storage in said second storage medium."

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 8-16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsumi et al (U.S. Pat Pub 2001/0032088 A1), hereinafter referred to as Utsumi, in view of Kumagai (U.S. Pat 6512722 B2), hereinafter referred to as Kumagai.

Re claims 1 and 11: Utsumi teaches a content data transferring system for transferring content data selected from a first recording medium [Fig 1, elt 10: "1st STORAGE MEDIUM"] on which a plurality of content data have been recorded to a second recording medium [Fig 1, elt 30: "2nd STORAGE MEDIUM"] different from the first recording medium (¶16; Fig 1, elts 10 & 30; ¶34), the content data transferring system comprising:

a recording and reproducing apparatus configured to reproduce various types of recording medium identification information unique to the second recording medium (¶14, lines 1-12) including machine identification data (¶7; ¶10) and recording content data transferred from the first recording medium [Fig 1, elt 10: "1st STORAGE MEDIUM"] to the second recording medium [Fig 1, elt 30: "2nd STORAGE MEDIUM"] (Fig 1, elts 20 & 23; ¶15, ¶16 and ¶47);

a reproduction control information [Fig 2, elts 41 & 42: use information] creating device configured to create reproduction control information about the content data with the second set (¶44); and

a content transfer controlling device configured to transfer content data recorded on the first recording medium [Fig 1, elt 10: "1st STORAGE MEDIUM"] to the second recording medium [Fig 1, elt 30: "2nd STORAGE MEDIUM"] so as to record the content data onto the second recording medium [Fig 1, elt 30: "2nd STORAGE MEDIUM"] in accordance with the reproduction control information created in accordance with the recording medium identification information about the second recording medium [Fig 1, elt 30: "2nd STORAGE MEDIUM"] (§§36, §42 and §44), the recording medium identification information being reproduced by the recording and reproducing apparatus (§§37).

However, Kumagai teaches:

first set creating means for creating a first set [Table Of Contents information/file management table] (Figs 13 & 15), the first set being used to correlate the recording medium identification information with a second set [Table Of Contents information out of the CD 55], the second set [Table Of Contents information out of the CD 55] being used to categorize the content data recorded on the first recording medium in accordance with a predetermined rule (col 23, lines 45-63; col 24, lines 16-23; col 25, lines 20-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Utsumi reference as described for the purpose of providing TOC information to the second medium to expedite the searching of desired files on the duplicated medium.

The combination of Utsumi and Kumagai teaches:

second set creating means for creating the second set correlated with the first set (Kumagai: Fig 16; col 25, lines 20-32 and col 26, lines 7-10) (Utsumi: Fig 2, elts 41 and 42; ¶36, lines 10-14; page 4, ¶42, lines 2-7 and ¶44, lines 19-24).

Re claims 2 and 12: Utsumi in view of Kumagai teaches the content transfer controlling device is configured to transfer the created reproduction control information to the recording and reproducing apparatus so as to record the created reproduction control information onto the second recording medium (Utsumi: ¶42 and ¶44).

Re claims 3 and 13: Utsumi in view of Kumagai teaches when it has been determined that the reproduction control information newly created in accordance with the recording medium identification information reproduced from the second recording medium does not match the reproduction control information recorded on the second recording medium, content data that have not been recorded onto the second recording medium are transferred to the second recording medium in accordance with the newly created reproduction control information (Utsumi: ¶42 and ¶51).

Re claims 4 and 14: Utsumi in view of Kumagai teaches wherein the content data recorded on the first recording medium are managed in accordance with the number of permissible record times [devolution value] for each of content data transferred from the first recording medium to other recording mediums, and wherein when each of content data which have not recorded on the second recording medium is transferred thereto, the number of permissible record times for each of the content data is decremented (Utsumi: ¶42 and ¶51).

Re claims 5 and 15: Utsumi in view of Kumagai teaches when content data that have not been recorded on the second recording medium are transferred thereto, the newly

created reproduction control information is transmitted to the recording and reproducing apparatus so as to record the newly created reproduction control information onto the second recording medium (¶42, ¶44 and ¶51).

Re claims 6 and 16: Utsumi in view of Kumagai teaches content data that are not managed in accordance with the newly created reproduction control information are deleted from the second recording medium in accordance with the newly created reproduction control information (Utsumi: ¶46). Utsumi teaches the destruction of the key for decrypting said content and thus renders the content inaccessible.

Re claims 8 and 18: Utsumi in view of Kumagai teaches the reproduction control information is information with which the reproduction order of content data is controlled (Kumagai: Figs 12 & 13; col 23, lines 32-54).

Re claims 9 and 19: Utsumi in view of Kumagai teaches the second recording medium can be loaded into and unloaded from the recording and reproducing apparatus (Kumagai: Fig 1 elts 50, 80 and 82; col 7, lines 39-65).

Re claims 10 and 20: Utsumi in view of Kumagai teaches the reproduction control information is created whenever the second recording medium is loaded into the recording and reproducing apparatus (Utsumi: ¶34). Utsumi teaches a hard disc drive which is always present for use for copying media.

4. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsumi et al (U.S. Pat Pub 2001/0032088 A1), hereinafter referred to as Utsumi, in view of



Kumagai (U.S. Pat 6512722 B2), hereinafter referred to as Kumagai, in further view of Matsushima et al (U.S. Pat Pub 2002/0161571 A1), hereinafter referred to as Matsushima.

Re claims 7 and 17: Utsumi in view of Kumagai teach all the limitations of claims 6 and 16 as previously discussed. Utsumi in view of Kumagai additionally teach each of content data recorded on the first recording medium is managed in accordance with the number of permissible record times for each of the contents that are recorded from the first recording medium onto other recording mediums (Utsumi: ¶42, ¶44 and ¶51),

However, Matsushima teaches the number of permissible record times [permitted number] for each of content data is incremented when each of the content data is deleted from the second recording medium (¶3 and ¶10). Matsushima teaches that checked-out content that is checked-in is rendered unusable and the checked-out count is incremented.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the combination of Utsumi and Kumagai reference to increment the permissible record times, as taught by Matsushima, for the purpose of allowing flexibility in the content management scheme while simultaneously maintaining protection on restricted content.

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is

respectfully requested from the applicant in preparing responses to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the text of the passage taught by the prior art or disclosed by the examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat 6748539 B1

U.S. Pat 6832319 B1

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARREN SCHWARTZ whose telephone number is (571)270-3850. The examiner can normally be reached on 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S./  
Examiner, Art Unit 2435  
/Kimyen Vu/  
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